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## PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

JUR-PT001.1

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on May 11, 2006

Signature

Typed or printed name Jeffrey M. Glabicki

Application Number

10/079,330

Filed

February 20, 2002

First Named Inventor

Schwartz et al.

Art Unit

2682

Examiner

Tuan A. Tran

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

 applicant/inventor. assignee of record of the entire interest.  
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.  
(Form PTO/SB/96) attorney or agent of record.  
Registration number 42,584 attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 \_\_\_\_\_

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Telephone number

May 11, 2006

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.  
Submit multiple forms if more than one signature is required, see below\*.

 \*Total of 1 forms are submitted.

This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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**PATENT**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In the **PATENT APPLICATION** of:

Schwartz et al.  
**Application No.:** 10/079,330  
**Confirmation No.:** 7961  
**Filed:** February 20, 2002  
For: PORTABLE EAR DEVICES  
Group: 2682  
Examiner: Tuan A. Tran

Our File: JUR-PT001.1  
Date: May 11, 2006

**REASONS FOR PRE-APPEAL BRIEF REQUEST FOR REVIEW**

Mail Stop AF  
Commissioner for Patents  
P.O. Box 1450  
Alexandria, VA 22313-1450

Sir:

This Communication is being filed in response to the Final Office Action dated January 11, 2006 and is submitted in conjunction with an appropriate petition for extension of time.

A Pre-Appeal Brief Review is hereby requested in the above application for the following reasons:

In the Office Action, claims 9-20 and 29-38 stand finally rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent No. 6,449,374 (Skulley et al.). Claims 9, 29 and 35 are the only independent claims.

Referring to Figure 3A of Skulley et al. (below), the Skulley et al. headset assembly has a receiver/transmitter assembly 22 with a receiver element 56. The receiver/transmitter assembly 22 is connected to a spindle 40 which is coupled to an ear hook (not numbered) with cord guides 58. The spindle fits in a recess 54.

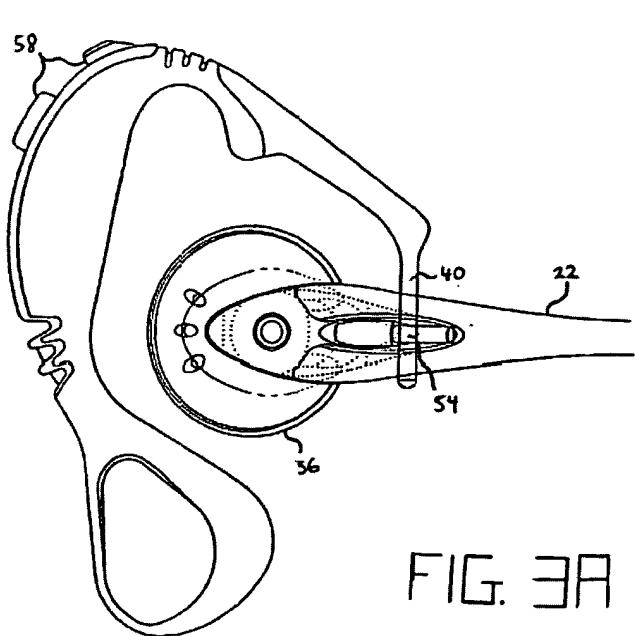


FIG. 3A

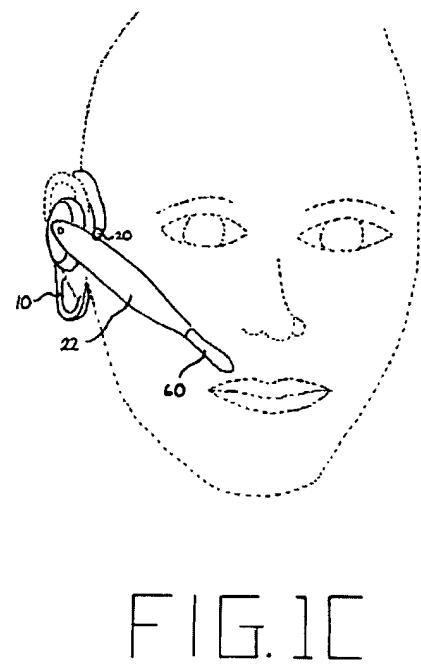


FIG. 1C

The Skulley et al. headset assembly is dramatically different from the present claims. Referring to the present claims, claim 9 refers to "a housing containing a recording device"; claim 29 refers to "a housing containing a transmitting and receiving device"; claim 35 refers to "the housing containing substantially all other components of the ear-wearable device other than the speaker." In Skulley et al., the only element that would contain any components is the transmitter/receiver assembly 22. The ear hook 10 is described as a member of

thermoplastic and can carry a cord on top of itself using guides 58. Accordingly, the earhook of Skulley et al. can not be considered the housing of the present claims, as it contains no components at all.

Claims 9, 29 and 35 refer to “the housing lying on and biasing against a top portion of the ear and head connection of the wearing individual” or a similar recitation. The receiver/transmitter assembly 22 of Skulley et al. goes from the listener’s ear to the listener’s mouth and does not bias against a top portion of the ear and head connection. As a result, Applicants believe that the Examiner considers the combination of the receiver/transmitter assembly 22 and the ear hook 10 to be the housing. Although Applicants do not believe that one skilled in the art would consider an ear hook to be a part of the housing, such an interpretation of the housing fails in context with other elements of the claims.

Claims 9, 29 and 35 refer to “a member extends from the component to a front of the top portion of the ear and head connection and the member being connected to the housing” or a similar recitation. The component directs sounds into the ear. This member is totally inconsistent with the interpretation that the combination receiver/transmitter assembly and earhook of Skulley et al. can be equated to the housing of the present claims. Assuming that the receiving/transmitting assembly and ear hook combination of Skulley et al. could be considered the housing, there would be no member connected to the housing, as the whole Skulley assembly would be the housing and any such member would be a part of the housing and not connected to the housing.

Additionally, the receiver/transmitter assembly 22 of Skulley et al. is an integrated unit with the receiver element 56, which has the speaker. Accordingly, there is no member extending from the component and coupled to the housing of Skulley as they are integrated together as illustrated in both Figures 3A and 1C.

Skulley et al. discloses a spindle 40. The spindle connects the receiver/transmitter assembly 22 to the earhook 10. As shown in the figures, the spindle is not connected to the receiving element 56, but is connected to the receiver/transmitter assembly 22. Accordingly, the spindle is not the same as the member of the present claims. Also, the spindle connects the receiver/transmitter assembly 22 to the ear hook 10. The spindle could only be considered connected to the housing and not part of it if the receiver/transmitter assembly 22 by itself is considered the housing. If only the receiver/transmitter assembly 22 is considered the housing, it does not lie and bias on a top portion of the ear head connection. Accordingly, the Skulley et al. does not disclose a member connected to the housing which lies on the ear head connection.

As mentioned in the Final Action, Skulley et al., does not disclose a component that is configured to fit substantially inside a concha portion of a wearing individual's ear. The Final Action states,

Skulley does not explicitly mention that the module speaker is configured to fit substantially inside a concha portion of the ear. Since the speaker module of a headset having a size that can be fitted in a concha portion of the listener's ear is very common in the art (Official Notice taken by the Examiner); therefore it would have been obvious to one of ordinary skill in the art at the time the invention was made to configure the speaker module as disclosed by Hahn with the size that can be fitted in the concha portion of the ear for the advantage of allowing greater customization in the fitting of the headset module to the user's ear.

Actually, Skulley et al. refers to the receiver element fitting over the ear. Column 7, lines 56-59. Accordingly, the Skulley disclosure is contrary to the component fitting into the ear, as "over" is completely different than "into". The present claims refer to the component fitting substantially into a concha of the ear. The concha is the small hollow portion of the ear leading to the ear canal. It also

**Applicant:** Schwartz et al.  
**Application No.:** 10/079,330

refers to the component as biasing against the concha. This allows for greater stability. This is not disclosed by Skulley et al. In particular, please look at Figure 1E which illustrates the receiver element which would fit over (not into) the concha and other portions of the ear. Furthermore, the combination of the component biasing against the concha and the housing lying on the ear head connection allow for good stability and comfort, which is not disclosed by Skulley et al. Accordingly, Skulley et al. fails to disclose many of the features of the Independent claims and the claims are allowable.

With respect to claim 9, Skulley et al. does not disclose a recording device so this claim is further distinguished. With respect to claim 35, Skulley et al. does not disclose an amplifier.

In view of the foregoing remarks, Applicants respectfully request a Pre-Appeal Brief Review and a notice to that effect is respectfully requested.

Respectfully submitted,

Schwartz et al.

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